

STATUS OF CLAIMS

Claims 1, 3-15, 55, 56, 58-62, 64-67, 70 and 71 are pending.

Claims 1, 3-15, 55, 56, 58-62, 64-67, 70 and 71 stand rejected.

REMARKS

Change of Correspondence Address

Applicant has included herewith a form PTO/SB/122, requesting that all further correspondence be directed to the address associated with PTO Customer Account 45722.

35 U.S.C. 103(a) Rejections

Claims 1, 3-15, 55-56, 58-62, 64-67 and 70-71 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Leatherman (United States Patent No. 5,544,044) in view of Johnson (United States Patent No. 4,987,538) further in view of Shults (United States Patent No. 6,324,516). Applicant traverses these rejections for at least the following reasons.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See, e.g., In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)*. Applicant submits the cited art fails, in any combination, to teach, or suggest, each of the recited limitations of any of the pending claims, and hence fail to render any of the pending claims unpatentably obvious.

1. Leatherman, Johnson and Shults fail, in any combination, to teach, or suggest, each of the limitations of any of Claims 1-15

More particularly, Claim 1 recites, in part, “a workers' compensation claims verification system adapted to: ... if there is no matching workers' compensation claim number, automatically send an indication of the lack of determining the workers' compensation claim

number to a selected one of a plurality of payer computers.” The cited prior art fails to teach, or suggest, such a limitation.

For non-limiting purposes of explanation, this aspect of the present invention is discussed on page 18 of the application as originally filed, where it teaches that an electronic form is sent to a provider computer, allowing the provider to enter a claim number request. The response is sent to a worker’s compensation server, which checks a database. If the claim number is found, an indication of the claim number is sent to the provider computer. If no claim number is found, an e-mail notification can be sent to the payer computer as an alert, alerting the payer that a claim number is needed. The cited art fails to teach, or suggest, such an approach.

The August 2, 2005 Office action admits, “Leatherman and Johnson do not explicitly disclose the workers’ compensation claims verification system automatically sends an indication of the lack of determining the workers’ compensation claim number to a selected one of a plurality of payer computers.” *See, page 4, lines 8-11*. In an effort to remedy this admitted shortcoming of Leatherman and Johnson, the Office action attempts to rely upon select portions of Shults. The Office action relies upon lines 15-67 of column 7 of Shults to support the conclusion that Shults teaches a worker’s compensation claims verification system automatically sends an indication of a lack of determining the worker’s compensation number to a selected one of a plurality of payer computers. However, a detailed reading of the above passage reveals, with regard to Fig. 5 of Shults, that Shults merely teaches a bill line record that includes several enumerated fields. *See, e.g., col. 7, lines 16-34*. With regard to Fig. 6, the selected excerpt of Shults merely teaches a case header record that includes several enumerated fields. *See, e.g., col. 7, lines 35-67*. For purposes of completeness, col. 4, lines 31-37 of Shults also fail to teach, or suggest,

automatically sending an indication of the lack of determining the workers' compensation claim number to a selected one of a plurality of payer computers either. Instead, this excerpt of Shults merely teaches a system that can find a list of UR agreements, and apply corresponding UR agreements to bills. Thus, contrary to the assertions of the August 2, 2005 Office action, the selected portions of Shults clearly fail to teach, or suggest, a worker's compensation claims verification system that automatically sends an indication of a lack of determining the worker's compensation number to a selected one of a plurality of payer computers.

Accordingly, no combination of Leatherman, Johnson and Shults teaches, or suggests, at least, "a workers' compensation claims verification system adapted to: ... if there is no matching workers' compensation claim number, automatically send an indication of the lack of determining the workers' compensation claim number to a selected one of a plurality of payer computers" -- as is recited by Claim 1.

In view of the foregoing, Applicant respectfully requests reconsideration and removal of this rejection of Claim 1. Applicant also requests reconsideration and removal of the rejections of Claims 2-15 as well, at least by virtue of these claims' ultimate dependence from a patentably distinct base Claim 1.

2. *Leatherman, Johnson and Shults fail, in any combination, to teach, or suggest, each of the limitations of any of Claims 55 and 58-61*

Independent system Claim 55, analogously to Claim 1, recites, in part, "an indicator, wherein said databases are utilized to determine if the subset of the information includes a valid claim number, and if the subset of information does not include a valid claim number, the indicator produces an electronic signal that is transmitted to a payer computer" (emphasis added). Accordingly, Applicant respectfully requests reconsideration and removal of

the rejection of Claim 55 for at least the foregoing reasons. Applicant also requests reconsideration and removal of the rejections of Claims 58-61, at least by virtue of these claims' ultimate dependence from a patentably distinct base Claim 55.

3. *Leatherman, Johnson and Shults fail, in any combination, to teach, or suggest, each of the limitations of any of Claims 56, 62 and 64-67*

In similar fashion, independent method Claim 56, recites, in part, "generating an indication if the subset of the information fails to include a valid claim number." Accordingly, Applicant respectfully requests reconsideration and removal of the rejection of Claim 56 for at least the foregoing reasons. Applicant also requests reconsideration and removal of the rejections of Claims 62 and 64-67 as well, at least by virtue of these claims' ultimate dependency upon a patentably distinct base Claim 56.

4. *Leatherman, Johnson and Shults fail, in any combination, to teach, or suggest, each of the limitations of any of Claims 70-71*

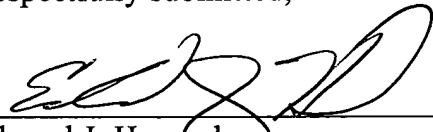
System Claim 70, analogously to Claim 1, recites, in part, "determine therefrom a matching workers' compensation claim number associated with said data; and, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to the provider computer." Accordingly, Applicant respectfully requests reconsideration and removal of the rejection of Claim 70 for at least the foregoing reasons. Applicant also requests reconsideration and removal of the rejections of Claim 71 as well, at least by virtue of this claim's ultimate dependency upon a patentably distinct base Claim 70.

CONCLUSION

Applicant believes he has addressed all outstanding grounds raised in the outstanding Office action, and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,



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